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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,700	04/15/2004	Yongcheng Li	RSW920040021US1QIMR-0072	6793
45541 7590 12/11/2008 HOFFMAN WARNICK LLC 75 STATE ST 14TH FLOOR ALBANY, NY 12207				
EXAMINER VO, HUYEN X				
ART UNIT 2626		PAPER NUMBER		
NOTIFICATION DATE 12/11/2008		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOCommunications@hoffmanwarnick.com

# Office Action Summary

Application No.

10/824,700

Applicant(s)

LI ET AL.

Examiner

HUYEN X. VO

Art Unit

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 19-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/15/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

***Response to Arguments***

1. Applicant's arguments have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Li (USPN 7318022).

***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-17 and 19-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
4. Claims 1-13 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing (Reference the May 15, 2008 memorandum issued by Deputy Commissioner for Patent Examining Policy, titled "Clarification of 'Processes' under 35 U.S.C. 101" – publicly available at USPTO.GOV, "memorandum to examining corps"). The instant claims neither transform underlying subject matter nor positively tie to another statutory category that

accomplishes the claimed method steps, and therefore do not qualify as a statutory process.

5. Claims 14-17 and 19-20 are drawn to a "system" as recited in the preamble. The specification, however, indicates that "the present invention can be realized in hardware, software, or a combination of hardware and software" (*paragraph 38 of the published application*). Therefore, the system claims are considered implemented in computer program and as such is non-statutory subject matter. See MPEP § 2106.IV.B.1.a. Data structures not claimed as embodied in computer readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention, which permit the data structure's functionality to be realized. In contrast, a claimed computer readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory. Similarly, computer programs claimed as computer listings *per se*, i.e., the descriptions or expressions of the programs are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional

interrelationships between the computer program and other claimed elements of a computer, which permit the computer program's functionality to be realized.

***Claim Rejections - 35 USC § 112***

6. Claims 21-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The term "computer-readable storage medium" is not found in the original specification. The original specification, however, includes various computer storage units. Since these various computer storage units are inherently readable by the computer system, applicant is allowed to amend the specification to include the term "computer-readable storage medium" to overcome this 112 issue.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-9, 11-12, 14-16, 19-23, and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richardson et al. (USPN 7295963) in view of Li (USPN 7318022).

9. Regarding claims 1, 8, 14, and 21, Richardson et al. disclose an autonomic translation method, computer-implemented business method, system (*computer system in figure 1*), and computer-readable storage medium (*computer-memory in figure 1*), comprising:

receiving content to be translated (*source document 302 in figure 3 or referring to col. 6, lines 47-56*);

translating the content from a first language into a single translation in a second language using a translation resource (*automatic translation 330 and automatically generated translation 304 in figure 3 or referring to col. 6, lines 47-56*);

providing translation process details corresponding to the translation to a user (*step 402 in figure 4; providing translation with confidence metrics*); and

receiving feedback pertaining to the translation based on the translation process details from the user (*steps 404-408 in figure 4*).

Richardson et al. fail to specifically disclose that the translation process details specifying, for a particular word in the content, a context of the translation that is based on words in the content surrounding the particular word in which the translating occurred. However, Li teaches that the translation process details specifying, for a particular word in the content, a context that is based on words in the content

surrounding the particular word in which the translating occurred (*col. 11, lines 5-33, surround context of the word in question; also referring to the operation of figure 5 for detail description of processing of relying on surround context of the word in question*).

Since Richardson et al. and Li are analogous in the art because they are from the same field of endeavor, it would have been obvious to one of ordinary skill in the art at the time of invention to modify Richardson et al. by incorporating the teaching of Li in order to improve translation accuracy by specifying the context or meaning of the word to the translator.

10. Regarding claims 2, 4-7, 15, and 22, Richardson et al. further disclose updating the translation resource based on the feedback (*referring to the operation of figure 4; updating is done based on translation and confidence metrics*), wherein the method is computer-implemented (*col. 3, lines 4-20*), wherein the content is received on a server over the network from a user operating a client (*col. 8, lines 15-53*), wherein the feedback is received from a user requesting the translation (*figure 4; the user correct translation*), wherein the providing step comprises displaying the content in the first language and in the second language in an interface page (*monitor 191 in figure 1; also referring to col. 8, lines 40-53*).

11. Regarding claim 3, Richardson et al. fail to specifically disclose the method of claim 1, wherein the translation process details specify a context in which the content was translated from the first language to the second language. Branson et al. teach

that the translation process details specify a context in which the content was translated from the first language to the second language (*col. 3, lines 25-51, "meaning code" is provided for end user to correct the translation; and or referring to col. 1, lines 33-46; the meaning of a word is determined based on surrounding words*).

Since Richardson et al. and Brandon et al. are analogous in the art because they are from the same field of endeavor, it would have been obvious to one of ordinary skill in the art at the time of invention to modify Richardson et al. by incorporating the teaching of Brandon et al. in order to improve translation accuracy by specifying the context or meaning of the word to the translator.

12. Regarding claims 9, 16, and 23, Richardson et al. further disclose providing an interface page to the user (*figure 5B, client computing device 522 includes monitor and input mechanisms for the user to enter source text*), wherein the confidence metric of the translation is displayed in the interface page (*client computer device 522 in figure 5B and also referring to monitor 191 in figure 1; or step 402 in figure 4; the context of the translation is taught in Brandon reference in claims 1 and 8*), and wherein the interface page includes a mechanism for the user to provide the feedback (*figure 5B, client computing device 522 and the operation of figure 4*).

13. Regarding claims 11-12, 19-20, and 25-26, Richardson et al. further disclose wherein the method is implemented over a network (*figure 5B*), wherein the user



operates a client and communicates the content to a server in the first language for translation into the second language (*figure 5B; server translation*).

14. Claims 10, 13, 17, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richardson et al. (USPN 7295963) in view of Li (USPN 7318022), and further in view of official notice.

15. Regarding claims 10, 13, 17, and 24, Richardson et al. fail to specifically disclose wherein the translation resource comprises a field dictionary, and the translating is performed on a subscription basis. However, examiner takes office official notice that domain-specific or field-specific dictionary and providing translation service to subscribed users are well-known in the translation art. It would have been obvious to one of ordinary skill in the art at the time of invention to readily realize that using domain- or field-specific dictionary would produce a more accurate translation and that the translation service is provided for subscribed users.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Li (USPN 7346487) is considered pertinent to the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUYEN X. VO whose telephone number is (571)272-7631. The examiner can normally be reached on M-F, 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Edouard can be reached on 571-272-7603. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Huyen X Vo/  
Primary Examiner, Art Unit 2626

12/5/2008

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